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Application Number	09/134,771
Filing Date	August 12, 1998
First Named Inventor	SAH et al
Examiner Name	S. Kaushal
Group Art Unit	1636
Attorney Docket No.	010624-0009-999

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**ENCLOSURES (Check all that apply)**

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| <input type="checkbox"/> Fee Transmittal Form<br><input type="checkbox"/> Fee Attached<br><input type="checkbox"/> Amendment/Reply (includes an Extension Request)<br><input type="checkbox"/> After Final<br><input type="checkbox"/> Affidavits/declaration(s)<br><input checked="" type="checkbox"/> Extension of Time Request<br><input type="checkbox"/> Express Abandonment Request<br><input type="checkbox"/> Information Disclosure Statement<br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input type="checkbox"/> Response to Missing Parts/<br>Incomplete Application | <input type="checkbox"/> Drawing(s)<br><input type="checkbox"/> Licensing-related Papers<br><input type="checkbox"/> Petition<br><input type="checkbox"/> Petition to Convert to a Provisional<br>Application<br><input type="checkbox"/> Power of Attorney, Revocation<br>Change of Correspondence Address<br><input type="checkbox"/> Terminal Disclaimer<br><input type="checkbox"/> Request for Refund<br><input type="checkbox"/> CD, Number of CD(s) : _____ | <input type="checkbox"/> After Allowance communication<br>to Technology Center<br><input type="checkbox"/> Appeal Communication to<br>Board<br><input checked="" type="checkbox"/> Appeal Communication to TC<br>(Appeal Notice, Brief, Reply Brief)<br><input type="checkbox"/> Proprietary Information<br><input type="checkbox"/> Status Letter<br><input type="checkbox"/> Other Enclosure(s) (please<br>identify below: |
| Remarks:<br>(X) Petition for Extension of Time (one month) (in duplicate);<br>(X) Response to Communication Concerning Applicant's Appeal Brief;<br>(X) Submission of Brief on Appeal<br>(X) Brief on Appeal in triplicate (with attached Exhibits 1 through 7)  |  |  |

**SIGNATURE OF APPLICANT, ATTORNEY OR AGENT**

Firm Or Individual Name	Pennie & Edmonds LLP Lawrence S. Graham, Reg. No. 49,020
Signature	<i>Lawrence S. Graham</i>
Date	November 7, 2003

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I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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made during prosecution to demonstrate previous traversal of the Examiner's assertion of equivalency of human and mouse mesencephalon progenitor cell types.

### **Response to Communication**

In the Communication, the Examiner indicated that the Appeal Brief is defective because it "does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number" as required by 37 C.F.R. 1.192(c)(5). Applicants have amended the Summary of the Invention to incorporate claim language and to refer to the specification by page and line number.

The Examiner also indicated in the Communication that:

[t]he brief is further defective because it raises new issues that were not presented before. The brief as filed requires that "The Examiner is called upon to file a Declaration to support the contention that rat neuronal stem or progenitor cells are equivalent to human neural stem or progenitor cells. Absent this, the rejection is improper." . . . This is a newly raised issue not presented before. Applicant[s] also did not previously traverse the equivalency of the cell types.

The non-equivalency of human and rat neural progenitor cells is not a new issue, nor is Applicants' position a new argument. Rather, this has been the focus of the prosecution for the last several years. The Examiner, in rejections of the claims under 35 U.S.C. § 103, has consistently combined art disclosing rat cells (*e.g.*, Hoshimaru *et al.*) with art disclosing human cells (*e.g.*, Boss *et al.*). Applicants have already argued against the combination of references on the basis of the non-equivalency of rat and human neural progenitor cells. *See, e.g.*, Paper No. 31, Amendment under 37 C.F.R. 1.116, page 4, Section I.B.2 and page 6, second paragraph; Paper No. 25, Amendment under 37 C.F.R. 1.111, page 5, third paragraph. Indeed, in Paper No. 32, Advisory Action, mailed April 14, 2003, the Examiner states "[t]he Applicant concluded that rat cells are [a] composition of matter that is different from human cells, therefore [the] invention as claimed is not obvious over the cited prior art of record."

In any case, even if, *arguendo*, Applicants' argument regarding the non-equivalency of the cell types were new, there is no prohibition in the rules preventing Applicants from making such an argument in the Appeal Brief.

The Examiner explicitly stated that "mammalian mesencephalon neuron progenitor cells (mouse and human) are considered to have identical characteristics . . ." for the first time in the Advisory Action (Paper No. 32) mailed April 14, 2003. It was this statement that

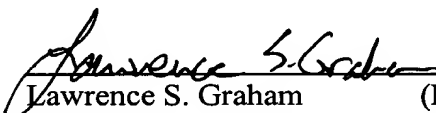
prompted Applicants to call for a supporting Declaration by the Examiner. As mentioned above, there is no prohibition against such a request. It raises no new rejections or issues other than the sufficiency of the Examiner's rejection. If the Examiner concedes that a Declaration is necessary to sustain the rejection, the proper action is allowance of the application or submission of such a Declaration.

Applicants believe that the Appeal Brief, as amended, is now in condition for entry.

Respectfully submitted,

Attorney for Appellants

Date: November 7, 2003

  
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Attachments